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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/176,067 10/20/98 DURANT

G 47578

EXAMINER

HM12/0328

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O SULLIVAN, P

ART UNIT

PAPER NUMBER

1621

DATE MAILED:

03/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/176,067

Applicant(s)
Durant et al.

Examiner
Peter O'Sullivan

Group Art Unit
1621



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) 7-9, 12-18, 20, 23, and 25 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-6, 10, 11, 19, 21, 22, 24, and 26-36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 1-36 are pending in this application which should be reviewed for errors. In response to the requirement for the election of a single disclosed species, applicants' elected group I, claims 1-6, 10, 11, 19-24, and 26-36, with traverse. Upon the further requirement for the election of a single disclosed species, applicants elected the species of N-(4-methylbenzoyl)-N'-(4-phenylbutyl)guanidine. Applicants' N-benzoyl, N'-phenylalkyl guanidines, not further substituted by heterocyclic, sulfur, nitrogen, carbonyl or oxygen containing substituents are examined therewith with all other compounds and accordingly, claims 7-9, 12-18, 20, 23 and 25 are held withdrawn.
2. Claims 1-6, 10, 11, 19, 21, 22, 24, and 26-36 are rejected under judicially created doctrine as comprising an improper Markush grouping. Applicants' compounds lack a common core. Applicants' compounds where R-R3 are variable are widely disparate. R1, for example, may be heterocyclic or alkylsulfonyl. A reference anticipating one of applicants' compounds would not necessarily render the others obvious.
3. Claims 19 and 25-36 are rejected under 35 U.S.C. 112, fifth paragraph as being multiply dependent claims dependent on other multiply dependent claims.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-4, 19, 21, 22, 24, 26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Okajima et al., Fukada et al., Augustin et al., Gund et al., Malyuga et al. (Claim 27 rejected instead of 28), and Neidlein et al. All of these references disclose anticipating N-Benzoyl, N'phenylalkyl guanidines.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).


7. Claims 1-4, 19, 21, 22, 24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulyuga et al. Mulyuga et al. disclose substituted N-benzoyl, N'benyl-guanidines as bactericides. The instant invention differs from that of Mulyuga et al. in that applicants' also claim position isomers/homologues of the compounds shown. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art at the

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time the invention was made to start with the teaching of Mulyuga et al., to make position isomers/homologues of compounds shown and to expect to make bactericides. Position isomers/homologues are held to be obvious. In re Mills 126 U.S.P.Q. 513.

8. Studt et al. is cited as state of the art only.

9. Any inquiry concerning this communication should be directed to Peter O'Sullivan at telephone number (703) 308-4526.


PETER O'SULLIVAN
PRIMARY EXAMINER
GROUP 1200